

REMARKS

Claim 5 is pending in the present application. Claim 5 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Patel (U.S. Patent No. 3,833,817). Applicants respectfully note that in the Office Action Summary, the Examiner indicates that Claim 1 is pending and rejected. This is incorrect, as claim 5 is the only claim pending.

By this amendment, Applicants cancel claim 5 and submit new claim 6. No new matter is added by this amendment. Support for this amendment can be found throughout the specification, and, for example, at pages 50-60.

By this amendment, Applicants do not acquiesce to the propriety of any of Examiner's rejections. This amendment, therefore, does not disclaim any subject matter to which the Applicants are entitled and is not intended to in any way narrow the subject the matter for which a patent is sought. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 USPQ2d 1865 (U.S. 1997).

I. REJECTION UNDER 35 U.S.C. § 102

Rejection of claim 5 under 35 U.S.C. § 102(b) as being anticipated by Patel (U.S. Patent No. 3,833,817)

The Examiner rejected Applicants' claim 5 under 35 U.S.C. § 102(b) as being anticipated by Patel, U.S. Patent No. 3,833,817 ("Patel"). Office Action at pages 2-3.

In order to aid prosecution and allowance, Applicants hereby cancel claim 5 without prejudice and submit new claim 6. By this cancellation, Applicants do not acquiesce to the propriety of the Examiner's rejection.

New claim 6 more clearly defines the subject matter of cancelled claim 5. Specifically, new claim 6 defines the elements of "HMI ballast" and "single common converter circuit." The Examiner stated, in rejecting claim 5, that "the recitation HMI ballast has not been given patentable weight because the recitation occurs in the preamble." Office Action at page 3. The body of new claim 6 states, "wherein said ballast is used in conjunction with one or more hydrargyrum medium-arc iodide (HMI) lamps." As this recitation is within the body of new claim 6, it should be given patentable weight.

The Examiner also stated, in rejecting claim 5, that the phrase “a single common converter” was not given patentable weight, as it was not included in the body of the claim. Office Action at page 3. The body of new claim 6 states “a single common converter circuit that operates in a split mode operation.” As this recitation is within the body of new claim 6, it should be given patentable weight.

In order to support an anticipation rejection under 35 U.S.C. § 102, the Examiner must show that each and every element of the claimed invention is shown identically in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) citing *Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988). Further, the elements of the prior art must be arranged as in the claims under review. *Id.*, citing *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Thus, the reference the Examiner asserts as prior art must contain all of the elements contemplated by the present invention in the same order and arrangement as presently claimed. Patel does not teach each and every element of new claim 6.

When the invention of new claim 6 is provided standard alternating current, it is used to convert the generic alternating current (“AC”) sinusoidal waveform into a “square wave voltage and current output.” See specification at 50. When the AC power coming into the ballast is positive, the ballast acts as an inverter during the times when the AC sinusoidal wave are beneath a certain threshold level, and acts as an converter during the times when the AC sinusoidal wave are above that threshold level. *Id.* Similarly, when the AC power coming into the ballast is negative, the ballast acts as an inverter during the times when the AC sinusoidal wave are above a certain threshold level, and acts as an converter during the times when the AC sinusoidal wave are below that threshold level. *Id.* As such, the invention of new claim 6 regulates the shape of the AC waveform into a “substantially square wave voltage and current output.” Patel fails to teach or suggest this element of new claim 6.

Patel relates to a circuit which “operates as a rectifier when AC power is provided and acts as an inverter when battery power is provided.” Office Action at 3. Patel does not, in any manner, teach or suggest regulation of the AC waveform. Examiner cites the last paragraph of column 4 in Patel to support his contention that

Patel relates to providing a “substantially square wave output.” Office Action at 3. However, this portion of Patel states that “[t]he DC-AC converter is ... designed to provide a square wave output.” Patel at column 4, lines 53-55. Patel thus does not teach or suggest such regulation of the AC waveform when AC power is provided.

Further, the invention of new claim 6 can operate simultaneously under both direct current (“DC”) power and AC power, using the DC power to supplement the AC power when necessary. See specification at 50-60. Patel does not teach or suggest this element of new claim 6.


As such, Patel does not teach or suggest the claimed invention and does not anticipate new claim 6 under 35 U.S.C. § 102(b).

CONCLUSION

Applicants have properly stated and traversed each of the Examiner's grounds for rejection. Applicants submit that the present application is now in condition for allowance.

If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited. If there are any additional fees due in connection with the filing of this amendment, please charge the fees to undersigned's Deposit Account No. 50-1067. If any extensions or fees are not accounted for, such extension is requested and the associated fee should be charged to our deposit account.

Respectfully submitted,



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